

**Neifeld Docket No:** CAT/29US-SCROCO

Application/Patent No: 09/401,939

USPTO CONFIRMATION NO: 5333

File/Issue Date: 9/23/1999

Inventor/title: Scroggie/System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network

Examiner/ArtUnit: Janvier/3622

**37 CFR 1.181 PETITION TO WITHDRAW THE NOTIFICATION OF NON-COMPLIANT**

**APPEAL BRIEF DATED APRIL 21, 2008**

Sir:

The examiner's requirements in the Notification of Non-Compliant Appeal Brief dated April 21, 2008 are improper. The appellant petitions the Director to reinstate the prior appeal brief.

## **I. STATEMENT OF RELIEF REQUESTED**

The appellant petitions the Director to instruct the examiner to:

- (1) withdraw the requirements in the "Notification of Non-Compliant Appeal Brief dated April 21, 2008" to submit an amended appeal brief;
- (2) expunge the requirement to submit an amended appeal brief mailed April 21, 2008 so that it does not detrimentally affect patent term adjustment;
- (3) expunge the replacement appeal brief submitted in response to the Notification of Non-Compliant Appeal Brief dated April 21, 2008;
- (4) reinstate the original appeal brief; and
- (5) specify in the decision that no Patent Term Adjustment (PTA) will be lost or reduced by the number of days in the time period from the filing the original brief or any replacement brief to the filing of the second replacement appeal brief. Cf. 37 CFR 1.704(c)(7).

## **II. STATEMENT OF MATERIAL FACTS**

1. On April 21, 2008, the examiner mailed a Notification of Non-Compliant Appeal Brief that on the second/final page stated that:

The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)). Check Box 2.

\* \* \*

The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)). Check Box 4.

\* \* \*

Section III Status of claims section must identify canceled claims. Section V Summary of claimed subject matter must argue each independent claim separately. Comments below Check Box 10.

2. The examiner previously stated on the record in the Examiner's answer mailed February 27, 2007 at page 2 line 11 that "The statement of the status of claims contained in the brief is correct."
3. A copy of Examiner's answer mailed February 27, 2007 is attached herewith as Attachment 1.
4. 37 CFR 1.2 states in pertinent part that: "The action of the Patent and Trademark Office will be based exclusively on the written record in the Office."
5. The examiner stated on the record in the Examiner's answer mailed February 27, 2007 at page 2 line 16 that "The summary of claimed subject matter contained in the brief is correct."
6. The examiner's answer mailed February 27, 2007 is in response to the appeal brief filed November 10, 2006. The notification of non-compliant appeal brief mailed April 21, 2008 is in response to the appeal brief filed April 9, 2008. The summary of the claimed subject matter in both the appeal brief filed November 10, 2006 and in the appeal brief filed April 9, 2008 are identical.
7. 37 CFR 41.31(c)(1)(v) Summary of the Claimed Subject Matter, states that:

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

8. There is no requirement in 37 CFR 41.31(c)(1)(v) that each independent claim must be argued separately.

9. 37 CFR 1.704(c)(7) may reduce PTA by the period between when a defective paper purporting to respond to an action was filed to the date a paper curing the defect was filed.
10. There is no fee associated with filing this petition.

### **III. REASONS WHY THE RELIEF REQUESTED SHOULD BE GRANTED**

The notification of non-compliant appeal brief mailed April 21, 2008 is improper because the brief was either compliant or the appellant relied upon the examiner's previous written statement that the brief was compliant.

#### **A. The Examiner's Requirements Regarding Deficiencies in the Status of the Claims are Improper**

The examiner's requirement in the notification of non-compliant appeal brief mailed April 21, 2008 on page 2 in (1) check box 2 for "a statement of the status of all the claims" and (2) in the comments below check box 10 for "Section III Status of claims section must identify canceled claims" are improper because they are contrary to the notice previously provided by the examiner that the same passage in an earlier brief was proper. Specifically, the examiner stated on the record in the examiner's answer mailed February 27, 2007 page 2 line 11 that "The statement of the status of claims contained in the brief is correct." A copy of the examiner's answer mailed February 27, 2007 is attached herewith as Attachment 1.

Thus, the examiner previously notified the appellant that the status of claims section was compliant, the status of claims did not change between the various filings during the appeal, and the examiner now asserts the status of claims is non-compliant. The appellant has relied on the examiner's written statement of acceptance of the appellant's statement of the status of the claims. Appellants are entitled to reply upon the notice function of papers issued by the PTO during prosecution. See, for example, 37 CFR 1.2, which states in pertinent part that: "The action of the Patent and Trademark Office will be based exclusively on the written record in the Office." Since the examiner's requirement in the notification of non-compliant appeal brief mailed April 21, 2008 contradicts the examiner's statement in the February 27, 2007 examiner's answer, the requirement is improper.

#### **B. The Examiner's Requirements Regarding Deficiencies in the Summary of the Claimed Subject Matter are Improper**

##### **1. The Examiner's Requirement that the "summary of claimed subject**

**matter must argue each independent claim separately is improper”**

The examiner’s requirement in the notification of non-compliant appeal brief mailed April 21, 2008 on page 2 in the comments below check box 10 that the “summary of claimed subject matter must argue each independent claim separately” is without basis in the rules. 37 CFR 41.31(c)(1)(v) Summary of the Claimed Subject Matter, states that:

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

There is no requirement in 37 CFR 41.31(c)(1)(v) that each independent claim must be argued separately. Therefore, the examiner’s requirement to that effect is improper.

**2. The Appellant has Complied with the Requirement of “a concise explanation of the subject matter defined in each of the independent claims involved in the appeal”**

In the notification of non-compliant appeal brief mailed April 21, 2008 on page 2 in check box 4, the examiner requires “a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v))”. This requirement is improper because the previously-filed appeal brief complied with 37 CFR

41.37(c)(1)(v)).

The appeal brief filed November 10, 2006 complied with the requirement. Pages 6-8, lists the subject matter defined in each of the independent claims 32, 45, and 58, referring to the specification by page and line number and to the drawings, if any. Therefore, the appellant has complied with 37 CFR 41.37(c)(1)(v)).

The examiner's requirement in the notification of non-compliant appeal brief mailed April 21, 2008 on page 2 in check box 2 for "a concise explanation of the subject matter defined in each of the independent claims involved in the appeal..." is improper because it is contrary to the notice previously provided by the examiner that the same passage in an earlier brief was proper.

Specifically, the examiner stated on the record in the examiner's answer mailed February 27, 2007 page 2 line 16 that "The statement of the summary of claimed subject matter contained in the brief is correct." A copy of the examiner's answer mailed February 27, 2007 is attached herewith as Attachment 1.

The examiner's answer mailed February 27, 2007 is in response to the appeal brief filed November 10, 2006. The notification of non-compliant appeal brief mailed April 21, 2008 is in response to the appeal brief filed April 9, 2008. The summary of the claimed subject matter is identical in both the appeal brief filed November 10, 2006 and in the appeal brief filed April 9, 2008.

The examiner previously notified the appellant that the summary of claimed subject matter was compliant. The examiner now asserts the summary of claimed subject matter is non-compliant, even though the summary of claimed subject matter did not change between the various filings during the appeal. The appellant has relied on the examiner's written statement of acceptance of the appellant's statement of the summary of claimed subject matter. Appellants are entitled to rely upon the notice function of papers issued by the PTO during prosecution. See, for example, 37 CFR 1.2, which states in pertinent part that: "The action of the Patent and Trademark Office will be based exclusively on the written record in the Office." Since the examiner's requirement in the notification of non-compliant appeal brief mailed April 21, 2008 contradicts the examiner's statement in the February 27, 2007 examiner's answer, the requirement is improper.

Finally, this petition is not moot due to 37 CFR 1.704(c)(7). 37 CFR 1.704(c)(7) reduces PTA by the period between when a defective paper purporting to respond to an action was filed to the date a paper curing the defect was filed.

5/20/2008

DATE

Respectfully Submitted,

/RichardNeifeld#35,299/

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Attorney of Record

Registration No. 35,299

BTM

Printed: May 20, 2008 (2:29pm)

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## UNITED STATES PATENT AND TRADEMARK OFFICE

RAN: Attorney Review: 3/6/2007  
BTM: Reminder - Reply Brief Due 4/27/07; 3/27/2007  
BTM: Deadline (Non-extendable): 4/25/2007  
RAN: Deadline (Non-extendable): 4/27/2007

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/401,939	09/23/1999	MICHAEL C. SCOGGIE	CAT/29US-SCROCO	5333 ✓
31518	7590	02/27/2007	EXAMINER	
NEIFELD IP LAW, PC 4813-B EISENHOWER AVENUE ALEXANDRIA, VA 22304			JANVIER, JEAN D	
ART UNIT		PAPER NUMBER		
3622				

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	02/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Examiner's Answer - CAT-29US-SCROCO-070301



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FEB 27 2007

**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/401,939

Filing Date: September 23, 1999

Appellant(s): SCOGGIE ET AL.

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Richard Neifeld  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed on Nov. 10, 2006 appealing from the Office action mailed on August 11, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The related appeals, interferences, and judicial proceedings known to the Examiner, which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending Appeal are shown on pages 4-6 of the Brief as reported by the Appellant.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

4,882,675	Nichtberger et al.	11-1989
6,321,208	Barnett	11-2001

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 32, 33, 35, 37-44, 45, 46, 48-57, 58, 59, 61-71 and 75 are rejected under 35 U.S.C. 102(b) as being anticipated by Nichtberger, USP 4,882,675.

As per claims 32, 33, 35, 37-44, 45, 46, 48-57, 58, 59, 61-70, 71 and 75, Nichtberger discloses a system for electronically distributing and redeeming, cents-off merchandise coupons. An electronic display of coupons valid for use in a particular store is presented to customers in that store via a terminal (personal computer). When a customer makes a selection of coupons from the display, coupled to the personal computer, the selection is recorded in a storage medium. The customer is subsequently identified, via an identification means or card (or receipt reminder or token associated with the selection), at a store checkout station as the one who had earlier made the selection. In a preferred embodiment, the identification is made by scanning a special card adapted for use with the system. The items purchased in the store by the customer are recorded and any matches between the coupons selected items, as featured in the selections (**or printed on the receipt reminder or token**), and the items purchased are determined electronically. Then the store checkout system totals the individual incentives related to each matched item currently in the customer's order to generate an accumulative incentive (generating a purchase incentive or accumulative incentive based on the individual matches between the purchased items and the selected coupon items presently in the customer's order), which is immediately credited in accordance with the terms of the matched coupons to the customer's purchase. Redeemed coupons are periodically cleared electronically.

A local unit 20 (personal computer) of fig. 1, associated with a point-of-transaction and coupled over a network to a central computer or main computer or operation center database storing coupon data, presents to the customer an electronic display of coupons available for selection by the customer when the customer insert a special card into the local unit 20 to identify himself. **The card may include a UPC code, which identifies the user and a magnetic stripe on which information (about the selected coupons) can be recorded.** The customer then selects the coupons, which he or she wishes to redeem later. **The CDR (coupon distribution and redemption) unit 20 records the selection and makes information identifying the customer and the selected coupons available to each of the checkout stations, which comprise the checkout system 18 of a supermarket. A receipt or a token, identifying the selected coupons, may be printed for the user's convenience. Here, it is understood that the receipt is simply a reminder, but not a coupon per se (col. 5: 1-16).**

After the user has made his or her purchases, during a transaction at a participating retailer or supermarket, he or she goes to one of the checkout stations and presents his or her special (proprietary) card, having encoded thereon the customer's identification data and other information (related to the customer's coupon selection at the display or local unit 20), to the attendant at the station. The attendant causes the card to be read by a suitable card reader (such as a UPC card scanner) and the checkout system 18 of fig. 1 then automatically credits the customer for the coupons, selected earlier at the display and recorded in a database, he had earlier selected where there are corresponding purchases against which the coupons are to be applied or when a purchased product in the customer's order matches a selected coupon item as read from the database **(or from the receipt reminder or from data encoded on the special**

**card) (receiving a token or special card, having encoded thereon the customer's identification and other information at a checkout and generating a purchase incentive or cumulative incentives by totaling individual incentives related to each selected coupon item in the customer's order and applying the cumulative incentives on the customer's purchase- Col. 5: 17-25).**

Thereafter, information regarding the redeemed selected coupons is transmitted to the central processing unit 16 (or main computer or clearinghouse) of fig. 1, which then automatically debits the manufacturer who distributed or provided the coupons in the first place and credits the supermarket or retailer corresponding to the local station 10 at which the coupon (selected coupons) was redeemed (compensating the retailer for honoring or redeeming the selected coupons- Col. 5: 26-31). Hence, in the preferred embodiment, selection (distribution), redemption and clearing are accomplished automatically without handling of paper coupons by customer or store and thus without the possibility of the types of fraud which now plague the industry (col. 5: 32-37).

See col. 5: 46 to col. 6: 28; col. 10: 51 to col. 11: 34

Further, during the customer's interaction with the coupon display 20 and coupon selection, after the last screen is presented and a user decision made, an "account choice" record or file (for the purpose of storing the customer's coupon selection) is created in a database **and a receipt or shopping list may be printed. The receipt or token, which is not a coupon per se, includes a receipt number, the product name, size and the savings amount. The printed receipt is used as a reminder to shoppers and can also be used to identify the users of cards,**

**which are not special cards at checkout time during a redemption process.** If a special card is used, a notation to that effect including the period of such use is magnetically recorded on the card memory for future use during a coupon selection transaction and to thereby measure the coupon and redemption effectiveness. The customer's coupon selections are entered in a database file for permanent storage and later retrieval during a redemption process at a supermarket (Col. 11: 35-45).

In general, coupon selection information is reported via a communications link or network (LAN or WAN or Intranet) to the local processor (for storage and later retrieval), which controls the store's automated checkout system. This facilitates a subsequent retrieval and comparison of coupon selected items (coupons selected) to purchased items before individual incentives related to matched items in the customer's order can be added, during a redemption, and applied to the customer's purchase (col. 11: 46-50).

During the introductory period, customers without a special card will instead be allowed to utilize selected cards having a magnetic stripe to activate the CDR unit or display 20 during a coupon selection transaction. **In this case, the number printed on the receipt or coupon selection reminder (token) can have operational significance if the receipt does not bear the account number and if the card does not display the account number in UPC code format.** The customer shops at a supermarket by purchasing items and proceeds to the supermarket checkout station. Since the reminder (token) bears the number under which the customer's selections are filed or recorded by the CDR unit 20 in a database, it (token) is presented at checkout time in lieu of the special card to thereby retrieve from the database the customer's

stored coupon selection, during a redemption, and to compare coupon items to purchased items and to effect a redemption, as described above (col. 11: 51-63; col. 13: 65 to col. 14: 7).

See col. 15: 27-43; col. 17: 30 to col. 18: 41.

**Claims 34, 47 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nichtberger, USP 4,882,675.**

As per claims 34, 47 and 60, although Nichtberger discloses adding or totaling individual incentives, associated with selected coupon items, based on the number of selected coupon items present in the customer's order during a transaction and applying the total individual incentives to the customer's purchase (See above), however, Nichtberger does not expressly teach applying the incentives in a subsequent transaction or shopping trip.

However, it is common practice in the art for a manufacturer or retailer to provide one or more discount coupons or cumulative incentives, during a single shopping at a retail store, to a customer based on whether or not one or more coupon items or triggering items are bought by the customer or based on the amount of money spent by the customer during the transaction, wherein the one or more discount coupons or cumulative incentives (generated voucher) are issued on a medium and redeemable on a subsequent shopping trip (See at least the "Off" Patent cited in the conclusion section).

"Official Notice"

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the publicly disclosed information (“Official Notice”), as shown above, into the system of Nichtberger so as to identify a customer at a checkout in a retail store, during a transaction including a redemption, and retrieve from a database coupon data (token data) selected earlier by the customer and stored in the database in order to determine if one or more items in the customer’s purchase match one or more items related to the selected coupon data as read from the database and to add up or total individual incentives associated with one or more selected and matched coupon items, based on the number of selected coupon items present in the customer’s order during a transaction, which yields to an accumulated purchase incentive (generating a purchase incentive) and to finally provide the (accumulated) purchase incentive or accumulated incentives, redeemable on a subsequent shopping trip, to the identified customer via a medium useful during the future or delayed redemption, thereby luring the customer back to the retail store or an associated POS to redeem the accumulated incentives, while buying more products and spending more money at the retail store checkout or associated POS, which in the end helps increase the retailer’s business bottom line.

**Claims 72-74 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nichtberger, USP 4,882,675 in view of Barnett, USP 6,321,208.**

As per claims 72-74 and 76, Nichtberger does not expressly disclose using a personal computer or a terminal, located at home or outside the retail store, to log onto a web site of the main computer or operation center central computer prior to transmitting promotional data (the

personal computer remotely accesses the central computer or main computer to select coupon data....).

However, Barnett discloses a system for distributing in an interactive manner over a computer network or the Internet by an online service provider 2 of fig. 1 electronic coupons (Virtual coupons) received from coupon issuer 14 or coupon distributor 16 to registered users using remote computers 6 of fig. 1 wherein a central repository or database 40 of fig. 6 associated with online service provider 2 stores electronic coupon packages and a database file 42 stores users' demographic data or profile data (name, address, income, etc.,), provided by the users during an online registration process with the online service provider 2, and survey responses given by the users. First, using a home personal computer, a user initially visits the online service provider 2 web site and downloads or accesses generic or untargeted electronic coupons or coupon data stored in database 40 and the demographic data collected from the user during the initial visit (registration process) are used to target specific coupon data packages for subsequently downloading by the user. It is further understood that those specific coupon data packages generated for the user or specific user are stored in the database 40 of the online service provider 2 along with uniquely created user-specific identification indicia uniquely identifying the user or customer using or participating in the online coupon distribution system (col. 7: 55 to col. 8: 5; Claim 1 of the current reference). Once the user joins the online coupon distribution system subsequent to the registration process during the initial visit, the user can connect or access or log into, by inputting via a keyboard his identification number or user-specific ID and/or login name, the online service provider 2 system having an associated web site where the said user can download (request) from database 40 of the online service provider 2 targeted

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coupon data, specifically directed to his attention, to his personal computer 6 where the coupon data can be stored in a local database 30 of fig. 2 or used by the user to print one or more coupons 70 as shown in fig. 5 using a printer 8 attached to the user's computer 6 (col. 8: 22-37; col. 8: 46-47; col. 6: 50 to col. 7: 11; col. 9: 33-52). The one or more printed coupons are presented for redemption in the normal or conventional fashion by the specific user or customer when shopping at a desired retailer. Following the redemption process, **subsequent to validating the presented coupons and applying the coupon values to the customers' transactions when the required products are purchased**, the redeemed coupon data are transmitted by the desired retailer to a coupon redemption center 13 where they are electronically read and the user-specific data are recorded in a coupon redemption database (D/B) 12. Additionally, the user's transaction data including the redeemed coupon data (redemption data) are provided to the coupon issuers (manufacturers) 14 and coupon distributors 16 of fig. 1 for integration into further marketing analysis (the retail location or the store 10 has means for gathering coupon data, electronically received from the online service provider 2 on behalf of specific customers, and means for forwarding redeemed coupon data to manufacturers or issuers 14 used to update their database and generate new targeted coupon packages for particular or identified customers associated with the redeemed coupon data); In other words, the coupon issuers 14 and coupon distributors 16 of fig. 1 utilize the user-specific data (coupons deleted, coupon printed and demographic data) along with the redemption data to update their database and generate or compile subsequent coupon packages targeted specifically or directed to the user's attention (using redemption data to update the user's virtual coupons or electronic coupons) (See abstract; col. 6: 58-65; col. 7: 12-20; col. 7: 45-55; **col. 11: 39-43**).

In another embodiment, the printable coupon data generation routine 32d combines all this information and generates a record indicative of the unique coupon to be printed. This record is temporarily stored in the output buffer 28, where it is subsequently sent to the printer 8 for printing. **In the alternative, the coupon may be redeemed electronically by sending the coupon data in the output buffer via the data communications interface 20 (Internet) back to the online service provider 2.** This is especially useful in the "electronic shopping mall" environment now found in many online services. **The electronic coupon data, related to coupons selected by the user, could also be routed via the data communications interface 20 to a retail store where the user will be shopping, where the coupon data is held in a buffer or database pending purchase by the user of the matching product (col. 11: 29-42).**

Therefore, an ordinary skilled artisan, implementing the system of Nichtberger, would have been motivated at the time of the invention, without reading the Instant Application, to incorporate the coupon distribution system of Barnett into the Nichtberger's system so as to enable a user to use a home personal computer to remotely access, upon logging, a web site (interface) related to the central computer (main computer) over a communication link or the Internet to select promotional coupons stored in the central computer database, wherein printable generated coupon data corresponding to the user's selections are electronically transferred to a redemption retail store database for permanent storage pending the purchase by the user of one or more matching products when the user identifies himself via a customer's loyalty card, thereby allowing millions of users to select in real-time promotional coupons, stored in the central computer database, by remotely accessing the central computer over a communication link or the Internet on a twenty-four hours, seven days a week and 365 days a year basis

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regardless of their geographic locations, while receiving redeemed coupon data from the redemption stores in real-time.

#### **(10) Response to Argument**

**First of all**, the Examiner herein withdraws the obviousness rejection of claims 71-76 as inadvertently reported on page 9 of the last Office Action. Further, that portion of the rejection did not even address the claim elements cited in claims 72-74 and 76. Moreover, the Appellant's remarks regarding the Claim Objections, as shown on pages 21-22 of the Brief, are herein being moot since issues raised under "Claim Objections" cannot be appealed. The Examiner also acknowledges the Appellant's reply to the Examiner's response, as shown on pages 17-18 and sections G-H of the Brief, and the points raised therein will be addressed as part of the general response.

**Second of all**, Appellant argues, regarding the 102 Rejection of at least the independent claims (32, 45 and 58), that Nichtberger (main reference) does not disclose "transmitting promotion data identifying a plurality of product discount from a main computer to a personal computer over a computer network" and that the Examiner agrees that the main reference does not disclose a personal computer as featured on page 12 and lines 5-9 of the last Office Action, which recites "As per claims 72-74 and 76, Nichtberger does not expressly disclose using a **personal computer, located at home or outside the retail store, to log onto a web site of the main computer.....**" (See pages 12 and 13 of the Brief). And the Appellant goes on, as shown on pages 13-15 (section D) of the Brief, by defining a personal computer with respect to the

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specification. As seen above, the Appellant implicitly admits that Nichtberger anticipates all the claim elements recited in at least the independent claims except for a personal computer.

Here, the Examiner completely and respectfully disagrees with the Appellant's findings. The Appellant has clearly misconstrued or misunderstood the Office Action. **Although, in the Office Action, the Examiner explicitly admits that Nichtberger does not teach a personal computer located at home or outside the retail store as recited in dependent claims 72-74 and 76, which were rejected under 35 USC 103(a) instead of 35 USC 102(b), however, the Examiner never states, contrary to the Appellant's conclusion, that Nichtberger fails to teach a personal computer as disclosed in the independent claims including independent claim 32 and dependent claims 71 and 75.**

First, as a matter of fact, the claims, as herein argued, or more specifically the independent claims, including claim 32, never recite, contrary to the Appellant's contention, a personal computer, located at home or outside the retail store, to log onto a web site of the main computer as featured in dependent claims 72-74 and 76. As seen in the step of "transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network", claim 32 merely refers to a personal computer, which is not immediately equal to a personal computer, located at home or outside the retail store, to log onto a web site of the main computer of dependent claims 72-74 and 76. In other words, it appears here that the Appellant is inappropriately reading limitations (specific definitions of a personal computer) from the specification into the claims (i.e. claims 32, 45, 58, 71, 75). To this end, the Examiner wants to remind the Appellant that although the claims are interpreted in light of the specification, however, limitations from the specification are

not being read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second, as a matter of principle, the Examiner prosecutes the claims based on their actual disclosure, but not for what the Appellant intends to feature in the claims and the claims, during prosecution, are broadly interpreted. Having said that, Nichtberger does anticipate, among other things, the argued **personal computer**. In fact, Nichtberger teaches a system wherein a local unit 20 (personal computer) of fig. 1, associated with a point-of-transaction/supermarket and coupled over a network (such as a LAN or WAN) to a central computer or main computer or operation center database storing coupon data, presents to the customer an electronic display of coupons, transmitted or received from the central computer database, available for selection by a customer when the customer insert a special card into the local unit 20 to identify himself. The card may include a UPC code, which identifies the user/customer and a magnetic stripe on which information (about the selected coupons) can be recorded. The customer then selects the coupons, which he or she wishes to redeem later. The CDR (coupon distribution and redemption) unit 20 (personal computer or PC) records the customer's selection and makes information identifying the customer and the selected coupons available to each of the checkout stations at the store, which comprise the checkout system 18 of a supermarket (the CDR or personal computer or PC has, inter alia, a local processor and a local memory for storing at least the customer's coupon selection and making it available to the store checkout stations over the network). A receipt or a token, identifying the selected coupons, may be printed for the user's convenience. Here, it is understood that the receipt is simply a reminder, but not a coupon per se (Col. 4: 42-53 to col. 5: 16; fig. 1). Contrary to the Appellant's definition, the CDR or local unit

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20, although not located at the customer's home or outside the retail store, is, for all intent and purposes, a personal computer or PC and does indeed meet the standard definition of a personal computer or PC, despite the connotation herein applied to "personal computer" by the Appellant, as one of ordinary skills in the art would have concluded at the time of the invention.

Third, the Examiner wants to remind the Appellant that it is improper to redefine a term or phrase, such as personal computer, that is well established and understood in the art. In fact, a personal computer or PC is a computer designed for use by a single user (as opposed to a file server) with all the capabilities that the user needs to perform basic computing tasks including the ability to store, retrieve and process information or data. IBM officially introduced its first single-user computer as the IBM PC (IBM personal computer) in 1981 and the term has come to represent, over the years, any computer based on the IBM standard (so-called IBM compatible computers or IBM clones). The other standard in the personal computer market is the Apple Macintosh. Personal computers or PCs are widely used at homes, at the stores, at the offices etc. and are being referred to at times as terminals, kiosks, workstations, clients and so on depending upon the locations where they are being used as long as they have a processor/microprocessor, memory means, among other things, coupled thereon, which enable them to store, retrieve and process information or data or simply perform basic and sophisticated computing tasks, as known in the art. In short, a computer, including a personal computer (PC), is one that computes, any programmable electronic device that can store, retrieve and process data. A Personal computer or Microcomputer (in reference to microprocessor) was known or available as far back to 1977. Thus, the CDR unit 20 (kiosk, terminal), as disclosed by Nichtberger fits well the basic

definition of a personal computer (PC) as herein presented and it is, ipso facto, a personal computer.

All in all, contrary to the Appellant's contention, the claimed personal computer as recited in at least independent claim 32 does not require browsing and e-mailing capabilities since the argued claims never recite such claim elements or capabilities. Here, the argued limitations are not necessarily present in at least independent claims 32, 45, 58 and dependent claims 71 and 75. Once again, the Appellant is improperly reading limitations from the specification into the argued claims.

In view of the foregoing response, the rejections of all the independent claims and the dependent claims are proper and thus, the Examiner's Action should be maintained.

**Third of all,** the Examiner does give patentable weight to a personal computer located at the customer's home or outside the retail store as featured in dependent claims 72-74 and 76 and as herein argued by the Appellant (See pages 11-15 of the Office Action). Furthermore, contrary to the Appellant's remarks, all dependent claims were addressed in the Office Action.

First, the rejection of claims 71-76 under 35 USC 103(a), as shown above, was inadvertently recorded and the related remarks as shown on page 15 and section E of the Brief are herein being moot.

Second, regarding dependent claims 33-39, Appellant argues that Nichtberger does not suggest "generating said purchase incentive comprises generating a voucher" and in fact Nichtberger teaches away from "printing a voucher at the POS". Here, the Examiner notes that the argued claims do not actually recite "printing a voucher at the POS or point of transaction"

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and "generating a voucher at the POS or point of transaction" does not automatically mean "printing the voucher at the POS or point of transaction". Furthermore, claims 33, 35 and 37-39 are anticipated by Nichtberger and arguments associated with "teaching away" usually deal with an obviousness-type rejection. Moreover, Nichtberger does teach encoding the customer's coupon selection data on the customer's special card (token) and/or printing the related information including a selection number on a receipt reminder (token) related to the coupon selection by the customer, wherein the printed receipt reminder (token/voucher) is used to validate a redemption by the customer at the checkout station (which reads on the step of generating a voucher (printed document) that can be used during the redemption of a coupon previously selected or generated at the local store or POS- see Office Action).

Coupon data and related parameters are transmitted, over a network, from the main computer or central computer to designated CDR Units 20 installed within a plurality of retail stores where they are made available to identified customers (Col. 18: 5-41). Further, the CDR unit 20, upon receipt of the ~~redemption~~ data and transaction data from a checkout processor of a retail store, also stores the information in memory/HDD within a local file of redemptions by customer (identification), as indicated at block 78 of fig. 4. Periodically, the local CDR unit 20 is called by the central computer or main computer to transfer the information comprising a special card number of a customer or an account number printed on a receipt reminder and a transaction number corresponding to a redemption, redeemed coupon data, data (product code, quantity, price, etc.) on other products purchased (without coupons) by selected customers, business day data and identification data of a CDR unit 20 or POS redeeming the incentives/coupons (Col. 9: 14-67). The central computer uses the information to compensate the stores where the

redemption takes place, bill the manufacturer(s) who provide the incentives in the first place, generate further marketing analysis and/or to generate more targeted incentives for a particular customer (providing or generating one or more incentives or coupons for a specific customers based on the redeemed coupon data related to the specific customer or based on the frequency or usage of the customer's card or a receipt reminder (token) used to facilitate or validate the redemption of the incentives).

Contrary to the Appellant's arguments, Nichtberger discloses a system, wherein during an incentive/coupon generation or selection, after the last coupon screen is seen on the CDR unit 20 and a customer's decision is made, the "account choice" record is created and a ~~receipt~~ or shopping list (token) may be printed (printing a token/voucher or a document that can be used by the customer during a redemption). The ~~receipt~~ includes a ~~receipt~~ number, the product name and size, and the savings amount. It is used as a ~~receipt~~ to shoppers or customers and can be used to identify the customers or users of frequent shopper's cards, which are not special redemption cards, at checkout time or during a redemption process. If a special card is used, a notation to that effect, including the period of such use, is magnetically recorded on the card (recording a special card usage), as indicated at 60. The customer's coupon selections are entered in a file in the memory of the CDR unit 20 for later retrieval during a redemption process at the checkout station, wherein the customer uses, for example, the receipt reminder to validate the redemption (col. 11: 35-45). Moreover, during the introductory period, customers without a special card will instead be allowed to utilize selected cards (frequent shopper's cards) having a magnetic stripe to activate the CDR unit or display 20 during a coupon selection transaction. In this case, the number printed on the receipt or coupon selection reminder (token) can have

**operational significance, especially if the receipt does not bear the account number and if the card does not display thereon the (customer's) account number in UPC code format.**

The customer shops at a supermarket by purchasing items and proceeds to the supermarket checkout station. Since the reminder (token) bears the number under which the customer's selections are filed or recorded by the CDR unit (PC) 20 in a local database, it (token) is presented at checkout time in lieu of the special card to thereby retrieve from the local database the customer's stored coupon selection, during a redemption, and to compare coupon items to purchased items and to effect a redemption, as described above (col. 11: 35-63; col. 13: 65 to col. 14: 7).

Third, with respect to dependent claims 72-74 and 76, contrary to the Appellant's conclusion, Barnett, the secondary reference, does address the deficiency in Nichtberger, the primary reference, and there is proper motivation to combine the references as described in the Office Action such that millions of users are able to select in real-time promotional coupons, stored in the central computer database, by remotely accessing the central computer over a communication link or the Internet on a twenty-four hours, seven days a week and 365 days a year basis regardless of their geographic locations, while receiving redeemed coupon data from the redemption stores in real-time and while increasing sales at the retail store, as one of ordinary skills in the art would have concluded at the time of the invention. Here, the fact the Appellant may disagree with the Examiner's motivational statements, as recorded in the Office Action, does not necessarily mean that the Examiner did not provide any motivation to combine.

Finally, the Appellant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the

Appellant's arguments as herein presented are not plausible and thus, the current rejections should be sustained.

**(11) Related Proceeding(s) Appendix**

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

JDJ

02/16/07

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